



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/505,285	10/27/2004	Lionel Breton	112701-432	6015

7590 09/13/2007
Robert M Barrett
Bell Boyd & Lloyd
P O Box 1135
Chicago, IL 60690-1135

EXAMINER

BARNHART, LORA ELIZABETH

ART UNIT	PAPER NUMBER
----------	--------------

1651

MAIL DATE	DELIVERY MODE
-----------	---------------

09/13/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/505,285	Applicant(s) BRETON ET AL.	
	Examiner Lora E. Barnhart	Art Unit 1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/22/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendments

Applicant's amendments filed 7/9/07 to claim 9 have been entered. No claims have been added or canceled in this reply. Claim 9 remains pending in the current application and is being considered on its merits. Prior art references not included with this Office action can be found in a prior action.

Claim Rejections - 35 USC § 112

Any rejections under 35 U.S.C. § 112 not particularly addressed below are withdrawn in light of the claim amendments.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 9 as amended requires the claimed composition to comprise "at least one probiotic lactic acid bacterium, or culture supernatant thereof, present in an ingestible carrier in an amount of at least 10^5 cfu/g," which is confusing. It is not clear whether the bacterium, the supernatant, or the carrier be present in an amount of at least 10^5 cfu/g. Clarification is required. In the interest of compact prosecution, the claim has been interpreted as being drawn to a composition comprising at least one lactic acid bacterium or culture supernatant thereof; at least one yeast; and at least one synthetic or natural carotenoid, said composition comprising these components in a carrier, each in a particular amount relative to the entire composition.

Claim Rejections - 35 USC § 102

The anticipation rejection of record is withdrawn in light of the amendments to the claims reciting particular amounts of each component.

Claim Rejections - 35 USC § 103

The amendments to the claims necessitate the following new ground of rejection.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shields, Jr. et al. (2000, U.S. Patent 6,156,355) taken in view of Spangler et al. (2003, U.S. Patent 6,524,574; reference A) and Hanna (1976, U.S. Patent 3,946,123; reference B). The claim is drawn to a pet food composition comprising at least 10^5 cfu probiotic lactic acid bacterium or culture supernatant thereof and at least 10^5 cfu yeast per gram of the composition, said composition further comprising between $10^{-12}\%$ and 20% of at least one carotenoid.

Shields teaches dog food formulations comprising dried yeast, vitamin A, beta carotene, probiotic bacteria (*Lactobacillus acidophilus* and *Enterococcus faecium*), and fermentation extracts of probiotic bacteria (*Bacillus subtilis*, *Aspergillus oryzae*, and *Aspergillus niger*), as well as numerous sources of protein, fat, and fiber (Examples 5 and 6; note in particular column 21, lines 48-49; 50-51; 54; and 60-63).

Shields, Jr. et al. do not explicitly teach the particular amounts of probiotic bacteria, yeast, or carotenoids in their composition.

Spangler teaches a pet food formulation comprising 3.3×10^8 cfu of probiotic lactic acid-producing bacterium (*Enterococcus* or *Lactobacillus*) and the yeast *Saccharomyces cerevisiae* per gram of the food formulation (column 4, lines 50-52, and column 5, lines 20-26 and 34-38)¹. Spangler teaches that the amounts of the bacteria and yeast relative to each other and to the composition may be varied as required by the person of ordinary skill in the art (column 4, line 66, though column 5, line 28).

Hanna teaches that carotenoids may be added to pet foods to impart desired color thereto and that the amount of carotenoid added is optimizable (column 3, lines 52-63).

The selection of the amount of probiotic bacteria, yeast, and carotenoids to be included in the composition of Shields, Jr. et al. would have been a routine matter of optimization on the part of the artisan of ordinary skill, said artisan recognizing that Spangler and Hanna teach that amounts of these components within a pet food composition may vary depending on the animal's dietary needs and the desired

¹ 150×10^9 cfu per pound is equivalent to 3.3×10^8 cfu per gram.

properties of the food composition. Furthermore, Shields, Jr. et al. teach that the nutritional needs of dogs, for example, vary by breed type (column 4, line 63, through column 5, line 33). A holding of obviousness over the cited claims is therefore clearly required, absent a showing of unexpected results. See *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007).

Therefore, the invention as a whole would have been *prima facie* obvious to a person of ordinary skill at the time the invention was made.

Applicant's comments regarding the now-withdrawn anticipation rejection have been considered to the extent they read on this new ground of rejection. Applicant alleges that Shields does not teach a composition comprising the claimed amounts of each component (Reply, page 4, last paragraph). These arguments have been fully considered, but they are not persuasive.

While Shields does not teach particular amounts of the components to be included in the composition, determining the relative amount of each would have been routine optimization on the part of the skilled artisan at the time of the invention, especially given Spangler's and Hanna's specific teachings that the amounts may be varied as desired.

In *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007), the Supreme Court reiterated the standard for overcoming obviousness rejections initially set forth in *Graham v. Deere*, namely convincing arguments that the cited art is non-analogous, a showing that the prior art teaches away from the claimed invention, or a showing of secondary considerations, e.g. truly unexpected results (see *KSR* at 1399).

"When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under §103" (see *KSR* at 1397). In light of *KSR*, this rejection would be overcome by a substantive evidentiary showing of unexpected results commensurate in scope with the claims or by a convincing argument that the cited art is not analogous.

The claim is not allowed. The claim is not free of the art.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

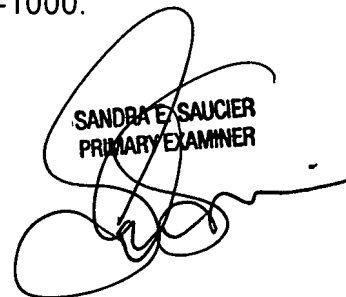
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lora E. Barnhart whose telephone number is 571-272-1928. The examiner can normally be reached on Monday-Thursday, 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lora E Barnhart



SANDRA E SAUCIER
PRIMARY EXAMINER